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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,378	03/01/2002	Robert Anthony Luciano JR.	GLF-01-001-CIP.1	4672
7590	08/24/2005			
Russ F. Marsden c/o Sierra Design Group 300 Sierra Manor Drive Reno, NV 89511			EXAMINER MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/087,378

Applicant(s)

LUCIANO, ROBERT ANTHONY

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 13-20, 22, 25-28, 30, 33, 34, 36, 39-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 13-20, 22, 25-28, 30, 33, 34, 36 and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION



Claims 1-8, 10, 13-20, 22, 25-28, 30, 33, 34, 36, and 39-42 are pending.

This action is Final.

In response to the RCE filed 7-11-2005



Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11th 2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 4-6, 8, 13, 16-20, 25-28, 33-34** and **39-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderan (US 5,743,815) in view of Vincent (US 5,102,140).

Regarding claims **1, 8, 20, and 33-34**. Helderan teaches the use of a golf ball identification system including targets comprising the entry, exit and guide portion as so claimed (Col 5:1-4), the use of RFID tags (Col 1:44-47), the use of two RFID readers per target (Col 4:60-63), a sign for allowing players to see their scores or standings (72), and a computer (server as so claimed) containing a data base for storing calculated player with associated player ball data (Col 1:48-52).

Helderan however is silent on the incorporation of game based on a pari-mutuel pool as so claimed. In a similar golf system Vincent teaches the use of a pari-mutuel pool (Col 1:25-28 & 3:49-54). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the pari-mutuel prize feature of Vincent in the golf game of Helderan in order reward players with exemplary games and/or achieving a hole-in-one as taught by Vincent (Col 1:11-28).

Further the system of Vincent collects monies through wagers placed by the players on game events and on the occurrence of the predicted event (a hole in one) the outcome is verified by an attendant and the accrued monies or a percentage thereof received from prior player wagers are presented to the player as a prize (Abstract, Col 1:22-27, & Col 4:40-52). This payout structure corresponds to a system/method, which "determines and distributes winnings from a pool" and distributes those winnings to each player who correctly predicts a game outcome. As the player may only win a prediction responsive to the placement of a wager (Col 4:40-52), the placement of a wager enables the system for play. As no particular problem is solved or unexpected result obtained in allowing players to wager "differing bet amounts" the inclusion of such is deemed a matter of design choice. It would have been obvious to one of ordinary skill in the art to allow players to wager different amounts in the system/method of Helderman/Vincent in order allow the wagers to differ based on the difficulty of the wagering event from the plurality of such events taught by Vincent (Col 3:35-43).

Regarding claim 4 and in addition to the above stated, the invention of Helderman teaches the use of the RFID reader in the dispensing of the golf ball, the assignment of said golf ball to a player, and the recording of the assignment at the time of dispensing which reads on the detection of a ball placed on the launch area (Col 5:5-15 & Col 5:38-50) wherein the processing/storage device (Elm 32) is understood as the claimed server.

Regarding claims 5, 6, 13, and 19, and in addition to the above stated, the invention of Helderman teaches the use of multiple inter connected processing/storage

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devices (Col 3:63-65 & Col 4:4-8 & Col 5:38-50) operable in communication with each other and where in one of the servers contains a database configured to hold data target in association with player data (account data) and where the results maybe displayed to all users with in view of a sign (Elm 72) or authorized users as understood.

Regarding claim **16, 17, and 25-28**, and in addition to the above stated, Helderma teaches the association with a set of balls to a players name (Specific players account) or a number (anonymous) as so claimed (Col 5:8-14).

Regarding claim **18** in addition to the above stated, the association of a set of ball IDs with an account further comprises associating a set of ball ID's into a group and allowing the group to be accessible using a ball ID contained there in, is deemed a matter of design choice wherein no stated problem solved or unexpected result obtained in the claimed invention that has not been provided for in the rejection of claims **5, 6, 13 and 19** above under the invention of Helderma/Vicent.

Regarding claims **39-42**, and in addition to the above stated, Vincent teaches the use of multiple course placed side by side (Col 4:53-63) that corresponds to the claimed "system comprises a plurality of sites".

Claims **2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim **1** in yet further view of Majkrzak et al (US 3,828,353).

The invention of Helderma/Vincent teaches the use of the RFID reader in the target assembly described above but is silent regarding the type of antennas used in the assembly. Majkrzak et al teaches a helix-coilform antenna as so claimed. It would

have been obvious for one of ordinary skill in the art at the time of invention to have used the antenna of Majkrzak in the RFID readers of Helderma/Vincent in order to conserve space in the target assembly.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim 1 in yet further view of Born et al (US 5,949,679)

In addition to the above stated, the invention of Helderma/Vincent teaches the use of a scoreboard (72) for displaying game related data but is silent on the use of a WWW server or equivalently the Internet. Born et al however discloses the use of the internet for displaying and tracking the performance of players in golf related games (Col 19:44-52). It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the web based performance tracking system of Born et al in the invention of Helderma/Vincent in order to increase access to player data.

Claims 10, 14, 15, 20, 22, 30, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim 1 in yet further view of Takagi (US 5,513,841).

Regarding claims 10, 22, 30, and 36, and in addition to the above stated, the invention of Helderma/Vincent is silent regarding the use of mobile targets in their golf game. Takagi however in a similar golf game teaches the use of mobile targets in a golf game related to competition (Figures 1, 7, 9, 10). It would have been obvious for one of

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ordinary skill in the art at the time of invention to have incorporated the moving targets of Takagi in the invention of Helderma/Vicent in order to allow competition at different ranges.

Regarding claim **14** and in addition to the above stated, Takagi teaches the purchasing off balls from a vendor as a conventional method (Col 1:20-23).

Regarding claim **15** and in addition to the above stated, the ownership of the balls by the player is deemed a matter of design choice wherein no stated problem solved or unexpected result obtained in the claimed invention that has not been provided for in the rejection of claim **14** above under the invention of Helderma/Vicent/Takagi.

Response to Arguments

Applicant's arguments filed 8-24-2004 have been fully considered but they are not persuasive.

Applicant argues that a pari-mutuel betting system is not taught by Vincent for lacking the following elements:

- a. A player funded pool for a game event.
- b. The ability to apportion out the pool amongst all wagering players who succeed in the wagered endeavor.
- c. The apportion amount at least partially based on an amount wagered by a player, the total amount wagered by all players, the type of wager.
- d. The enablement of a RFID-equipped golf balls for game play.

However Vincent refers to the amounts received by the gaming device in totality as a "pool of money from which to pay prize money to those who succeed in achieving this elusive goal" and funded by golfers depositing coins in order attempt a given task of "hole-in-one" (Col 1:11-28). As Vincent has described a deposit of monies by players in order to attempt a goal with a reward derived from monies deposited player he has at the very least met elements a, b and d set forth above. Finally as a player must wager an amount to activate the system wherein such moneys are utilized to pay player prizes he has provided for element c as set forth above.

Applicant's arguments directed to features of pari-mutuel wagering have been repeated above with reflection to the applicant's arguments for clarity sake. If the applicant wishes to introduce elements beyond this scope they must provide evidence in support of such assertions and a correlation to their specification as originally filed.

Further the applicant argues towards an "inherent" ability of a pari-mutuel system to apportion winnings among players without clear evidence that such inherency would not carry forward to the device of Vincent as demonstrated above.

The newly presented claim limitation directed to "different bets" or the implications of a wagering system with differing wager amounts has been addressed under design choice above.

Starting on the first full paragraph of page 13 (applicant's remarks dated 7-11-05) the applicant broadly challenges the rejection and motivation to combine without addressing any specific components of the previous rejection. In absence of a specific

inquiry or challenge the examiner can only leave the applicant with the claim rejections and correlations contained herewith to address their concerns.

Starting on the third full paragraph of page 13 (applicant's remarks dated 7-11-05) the applicant requests citations for motivation elements (relied upon common knowledge to one of ordinary skill in the art) found in the combination of references relied upon in the presented rejections. In the same paragraph the applicant cites "to make a case of obviousness there must be a suggestion or motivation in the cited or in the knowledge available to a person of ordinary skill in the art" (MPEP 2143), setting forth the basis for the use of common knowledge motivations juxtaposed to the citations. The applicant proceeds to argue the motivations under the premise that the present motivational statements are so broad as to be true in any case or combination and hence would somehow be incapable of addressing this specific instance.

In response the applicant's direct example of Helderman and Vincent the applicant is reminded that both systems address the play of golf and more specifically the tracking of players' golf performance. In the presented combination Vincent is relied upon for a teaching of a pari-mutuel wagering system that records a player's performance responsive to wagers and awards a prize based on a set of criteria and drawn from accrued wagers received by the system. Hence the focus of the combination is the inclusion of a wagering system set forth with the performance tracking system utilizing RFID balls of Helderman. Both inventions are understood to be in a common field and perform related functions with regards to golf performance monitoring. With the preceding established and believed to be well apparent to both parties one is left

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with the conclusion that the applicant challenges the incorporation of gambling either in its present form or any general form to the invention of Helderman. The examiner's motivation for the inclusion of a wagering feature is set under common knowledge inherent to the function and popularity gambling itself (<http://en.wikipedia.org/wiki/Gambling> Not relied upon and provided for reference). That is to say that the attraction of wagering in most basic form is entertainment and rewarding players for skill or luck in a gaming atmosphere with the incentive of money has driven its popularity for well over 2000 years (http://www.14g.com/casino/knowledge/history_of/the_earliest_games/ Not relied upon and provided for reference). Hence though, the motivational statement may indeed be broad it does not diminish its potency and given the broadness of the pari-mutuel concept claimed the presented pari-mutuel wagering is suitably and broadly joined.

Conclusion

This is a RCE of Application No. 10/087,378. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571)272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

Chanda L. Harris
CHANDA L. HARRIS
PRIMARY EXAMINER